Remarks/Arguments

Reconsideration of the above-identified application in view of the present amendment is respectfully requested. By this amendment, claim 1 is amended and claim 2 is canceled. Claims 1, 3-5, and 7-10 are pending.

Claim 1 is amended to include the subject matter of claim 2. Claim 2 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Edge in view of Rink et al. This rejection is respectfully traversed.

The M.P.E.P. sets forth the criteria for a rejection for obviousness under 35 U.S.C. §103 as follows:

> To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

See, M.P.E.P. § 706.02(j) *citing* In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

There is no suggestion or motivation in Edge or Rink et al. or in the knowledge of one of ordinary skill in the art to combine the reference teachings of Edge and Rink et al. as proposed in the rejection of claim 2. The Office Action merely states that it would be obvious to do "so as to provide increased safety in crashes not requiring the airbag to be inflated and reduce the cost of producing the gas generator by integrating the deformable diffuser and the filter". However, this is

speculative. One of ordinary skill in the art will recognize that there is no need to modify Edge in the manner taught by Williams.

Edge generally discloses a crash-protection device having a hollow body 20 and a gas generator for inflating a gas bag mounted in the body 20. Secondary crash protection or protection at speeds below which the bag is designed to be deployed, is provided for by an energy-absorbing element 40. The element 40 is disposed within the inflatable bag and gas passes through the element 40 to deploy the inflatable bag. According to column 2, lines 56-58 of Edge, the energy–absorbing element is a collapsible perforated metal shell which surrounds the gas generator. Edge continues to state at column 3, lines, 4-14 that:

> "These perforations are of a size and disposition such as to impart the desired collapse characteristics to the shell 40. ....It wills therefore be appreciated that, when the gas generator 34 has been activated, gas thereform can pass readily through the perforations in the shell 40 to cause the bag 36 to inflate to provide the necessary protection under designated impact conditions".

Therefore, the only function of the perforations in the metal shell of Edge is to allow gas to readily flow through the perforations and to impart the desired collapse characteristics to the shell 40. Edge neither explicitly nor implicitly discloses nor suggests that the perforations will also remove minute or particulate matter. In addition, Figs. 1 and 2 of Edge show that the size of the perforations is relatively large. Thus, the perforated metal shell is clearly not designed to act as filter element to remove particular matter, and there is no suggestion to modify the metal shell of Edge to act as a filter element. In fact, one of ordinary skill in the art would not want to modify Edge to have very small perforations in the metal shell to remove

particulate matter because that could prevent the metal shell from collapsing to absorb energy.

Rink et al. fails to remove this deficiency. In fact, one of the objectives of the invention of Rink et al. is to provide a filter material with sufficient strength that it may be employed as the exterior housing for the inflator (Col. 1, lines 58-60). In the background of the invention, Rink et al states that an air bag filter should withstand the intense heat and pressure associated with the pyrotechnic airbag (See Col. 1, lines 32-34). In discussing the possible use of ceramic filters for air bags, Rink et al states the ceramics are not suited to tubular filters, where large hoop stresses are generated (Col. 1, lines 39-44). Thus, one of ordinary skilled in the art would be lead away from using the filter of Rink et al, because such a filter of "sufficient strength" would most likely not deform under stress.

It is respectfully suggested that the obviousness rejection to claim 2 using Edge and Rink et al. only seems plausible using hindsight after having the benefit of the Applicants' disclosure. The use of the teachings of the present invention to find obviousness is impermissible.

> The court must be ever alert not to read obviousness into an invention on the basis of applicant's own statements; that is, we must view the prior art without reading into that art applicant's teachings. The issue, then, is whether the teachings of the prior art would, in and of themselves and without the benefits of appellant's disclosure, make the invention as a whole obvious.

In Re Sponnoble, 160 USPQ 237 at 243 (CCPA 1969) (emphasis in original).

Accordingly, the Examiner must consider only the teachings of the prior art references. Without the teachings of the present invention, one of ordinary skill in

the art would not even consider combining the teachings of Edge and Rink et al. to attempt to arrive at the presently claimed invention. For the reasons set forth above, the rejection of claim 2, now amended claim 1, under 35 U.S.C. 103(a) fails to establish a prima facie case for obviousness, because there is no suggestion or motivation in Edge or Rink et al. or in the knowledge of one of ordinary skill in the art to combine the reference teachings of Edge and Rink et al. as proposed in the rejection of claim 2.

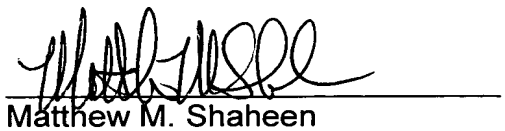
Therefore, in view of the above mentioned reasons, claim 1 is allowable. Claims 2-5, and 7-10 depend from claim 1 and are therefore allowable as depending from an allowable claim and also for the specific features recited therein.

Further, the rejection of claim 9 under 35 U.S.C. 103(a) as being unpatentable over Edge on view of Rink et al. and further in view of Kayser should be withdrawn for the additional following reason. Attached to this amendment is a certified copy of an English translation of applicant's patent application filed in Germany on December 12, 2002, which perfects the priority date of the application. Accordingly, the present application is entitled to the priority date of its German application. Therefore, U.S. patent application publication No. 2004/0004345 issued to Kayser with a U.S. filing date of June 11, 2003 for prior art purposes is after the applicant's filing date of December 12, 2002. Therefore, the Kayser reference does not qualify as prior art under 35 U.S.C. 103(a). Thus, the rejection of claim 9 should be withdrawn. Therefore, claim 9 is also allowable for this reason alone.

In view of the foregoing, it is respectfully submitted that the above-identified patent application is in condition for allowance, and allowance of the above-identified patent application is respectfully requested.

Please charge any deficiency or credit any overpayment in the fees for this amendment to our Deposit Account No. 20-0090.

Respectfully submitted,



Matthew M. Shaheen
Reg. No. 45,367

TAROLLI, SUNDHEIM, COVELL,
& TUMMINO L.L.P.
1300 East Ninth Street, Suite 1700
Cleveland, Ohio 44114-1400
Phone:(216) 621-2234
Fax: (216) 621-4072
Customer No.: 26,294